



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,976	01/21/2000	William J. Baer	STL000014US1	5177

23373 7590 07/01/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
----------	--------------

2162

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,976

Applicant(s)

BAER ET AL.

Examiner

HUNG Q. PHAM

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/13/2005 has been entered.

Response to Arguments

Applicant's arguments filed 04/13/2005 have been fully considered but they are not persuasive.

As argued by applicants at page 9 with respect to the amended features:

Independent claims 1, 4, 9, 12, 17 and 20 have been amended to recite some variation of a user or the defining means defines the content object by a list of content entity identifiers and that the user-provided content is content supplied or created by the user or the defining means. The primary reference cited by the Examiner, McGraw, does not disclose such claim elements.

Examiner respectfully disagrees.

The screenshot II includes a plurality of chapters such as *The American Heritage, Constitutional Democracy...* The content of a chapter are sections such as *New! Reading 2: The Mischiefs of Faction, James Madison...* The content of each section is the texts content indicated by the number of pages of text. A section

Art Unit: 2162

under a chapter, or the text of a section is an example of the content that will be provided by user in order to compile a user own book by using the *Add* button (Screenshot III, and What is Primis Database Publishing in Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/>). When a user activate the *Add* button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the content of the chapter will be assigned an identifier that is the chapter name. Referring back to the screenshot II, four pages of text of *New! Reading 2: The Mischiefs of Faction, James Madison* as *user-provided content is received* by the server, *wherein the user-provided content is content supplied by the user* using the *Add* button.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action.

Claim Objections

Claims 1, 4, 9 and 12 are objected to because the clause *a user defining the content object by a list of content entity identifiers* does not have a parallel structure with the other clauses. Appropriate correction is required (*having a user defining the content object by a list of content entity identifiers*).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 17-26, 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 IV.B.2.(b):

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1-8, 17-26, 29 and 30, especially claims 1, 4, 17 and 20, in view of the above-cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be

computer-readable. The use of a computer is not evident in the claim. MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As in claim 31, the steps of *storing said custom content object in said one or more object servers; storing attribute information concerning the custom content object in said one or more object servers; and storing information specifying the custom content object and the attribute information in the library server* were not described in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

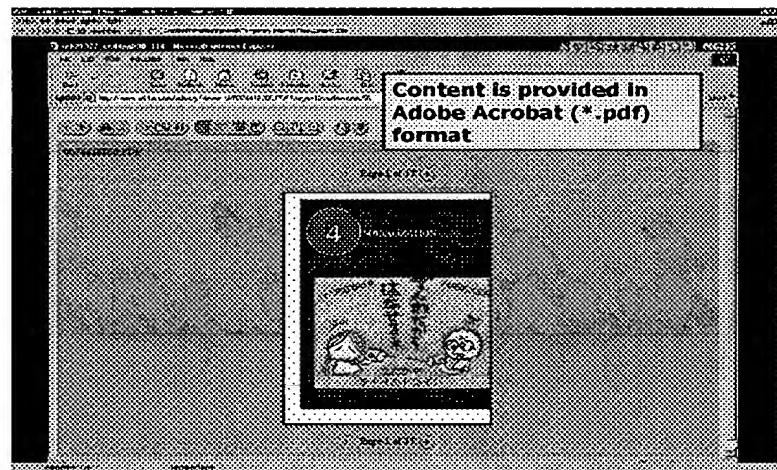
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

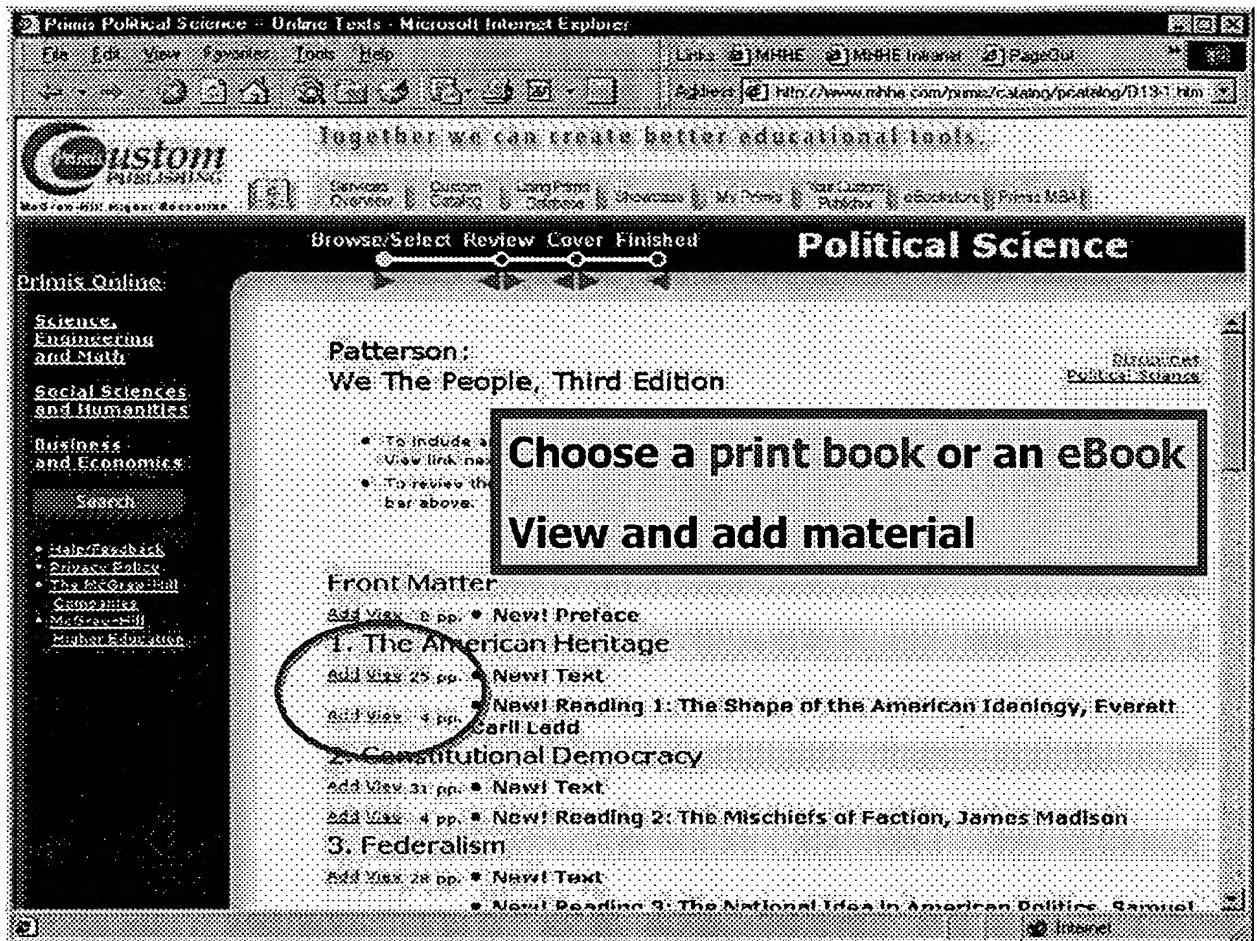
Claims 1, 4, 6, 7, 9, 12, 14, 15, 17, 20, 22, 23 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies (McGraw-Hill) [Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/> and <http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt>].

Regarding claims 1, 9 and 17, McGraw-Hill teaches a method and system for building an e-book as *a content object stored as a plurality of content entities*.

As shown at screenshot III, the e-book as *content object* is defined by a user by a list of chapters and sections as *content entity identifiers*.

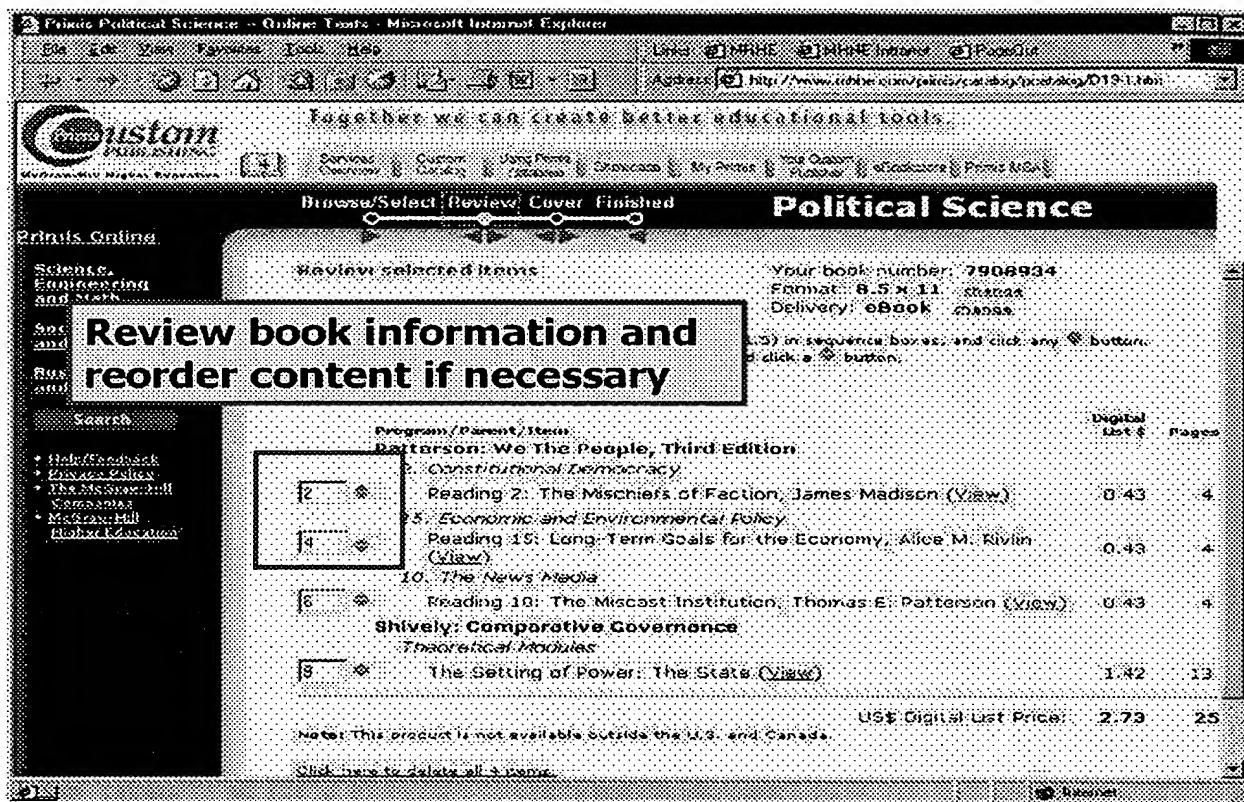


Screenshot I



Screenshot II

Art Unit: 2162



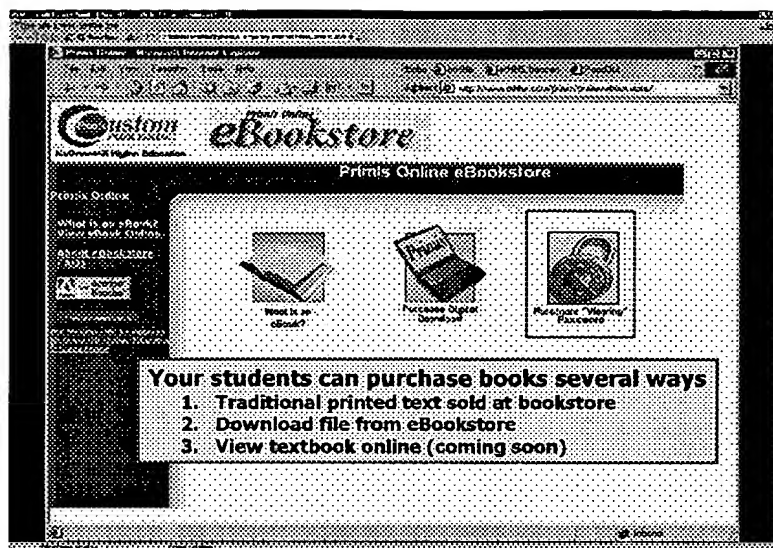
Screenshot III

The screenshot II includes a plurality of chapters such as *The American Heritage*, *Constitutional Democracy*... The content of a chapter are sections such as *New! Reading 2: The Mischief of Faction, James Madison*... The content of each section is the texts content indicated by the number of pages of text. A section under a chapter, or the text of a section is an example of the content that will be provided by user in order to compile a user own book by using the *Add* button (Screenshot III, and What is Primis Database Publishing in Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/>). When a user activate the *Add* button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the

content of the chapter will be assigned an identifier that is the chapter name. Referring back to the screenshot II, four pages of text of *New! Reading 2: The Mischiefs of Faction, James Madison* as *user-provided content* is received by the server, wherein the *user-provided content* is content supplied by the user when activating the Add button, section name *New! Reading 2: The Mischiefs of Faction, James Madison* as an identifier is assigned to four pages of the text.

The screenshot III illustrates a table of content or list of a user own book. The list is added with *New! Reading 2: The Mischiefs of Faction, James Madison* as the identifier of the four pages of text as *user-provided content* using the Add button of the screenshot III. The user can view four pages of *Reading 2: the Mischiefs of Faction, James Madison* as *user-provided content* by activating the view button.

McGraw-Hill does not explicitly teach the step of *storing* the user-provided content and its identifier *in the data repository*. However, as in the Presentation Presenting How To Use Primis Online (Screenshot IV), a user could download the e-book as one way to purchase the book. In order to download the e-book, obviously, the e-book that contains the *user-provided content and its identifier* has to be stored in a *data repository* at the server site.



Screenshot IV

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by storing the e-book in a data repository in order to build and download a customized e-book.

Regarding claims 4, 12 and 20, McGraw-Hill teaches a method and system for building an e-book as *a content object stored as a plurality of content entities*. As shown at the screenshot III, the e-book as *content object is defined* by a list of chapters and sections as *a hierarchical outline of containers and content entity identifiers*.

The screenshot II includes a plurality of chapters such as *The American Heritage, Constitutional Democracy...* The content of a chapter are sections such as *New! Reading 2: The Mischiefs of Faction, James Madison...* The content of each section is the texts content indicated by the number of pages of text. A section under a chapter, or the text of a section is an example of the content that will be provided by user in order to compile a user own book by using the *Add* button

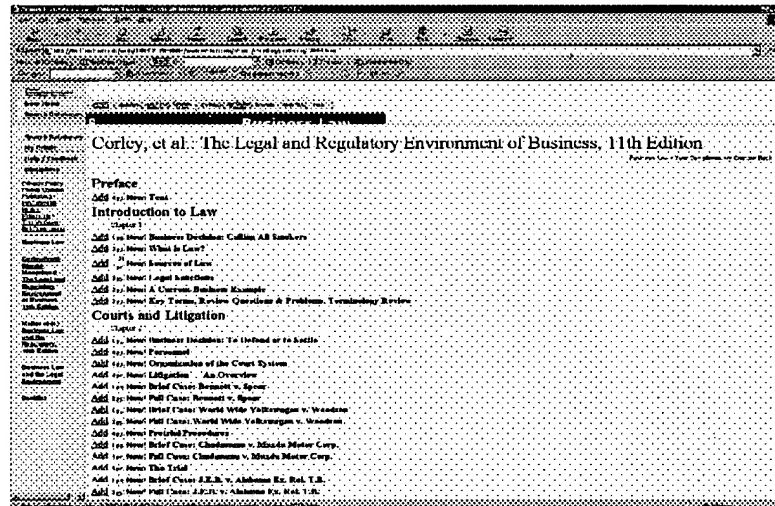
(Screenshot III, and What is Primis Database Publishing in Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/>). When a user activate the *Add* button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the content of the chapter will be assigned an identifier that is the chapter name. Referring back to the screenshot II, four pages of text of *New! Reading 2: The Mischiefs of Faction, James Madison* as *user-provided content* is received by the server when activating the *Add* button, section name *New! Reading 2: The Mischiefs of Faction, James Madison* as *an identifier* is assigned to four pages of the text. The screenshot III illustrates a table of content or hierarchical *outline* of a user own book. The *outline* is added with *New! Reading 2: The Mischiefs of Faction, James Madison* as *the identifier* of four pages of text as *the user-provided content* using the *Add* button of the screenshot II. The user can view four pages of *Reading 2: the Mischiefs of Faction, James Madison* as *user-provided content* by activating the *view* button.

McGraw-Hill does not explicitly teach the step of *storing* the user-provided content and its identifier *in the data repository*. However, as in the Presentation Presenting How To Use Primis Online (Screenshot IV), a user could download the e-book as one way to purchase the book. In order to download the e-book, obviously, the e-book that contains *the user-provided content and its identifier* has to be stored in *a data repository* at the server site.

Art Unit: 2162

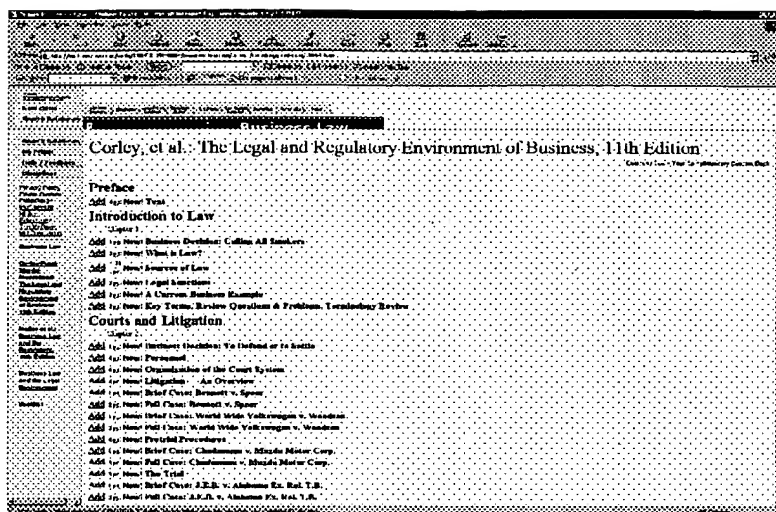
Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by storing the e-book in a data repository in order to build and download a customized e-book.

Regarding claims 6, 14 and 22, McGraw-Hill teaches all the claimed subject matters as discussed in claims 4, 12 and 20, McGraw-Hill further discloses *the user-provided content comprises a content entity* (McGraw-Hill Primis Custom Publishing).

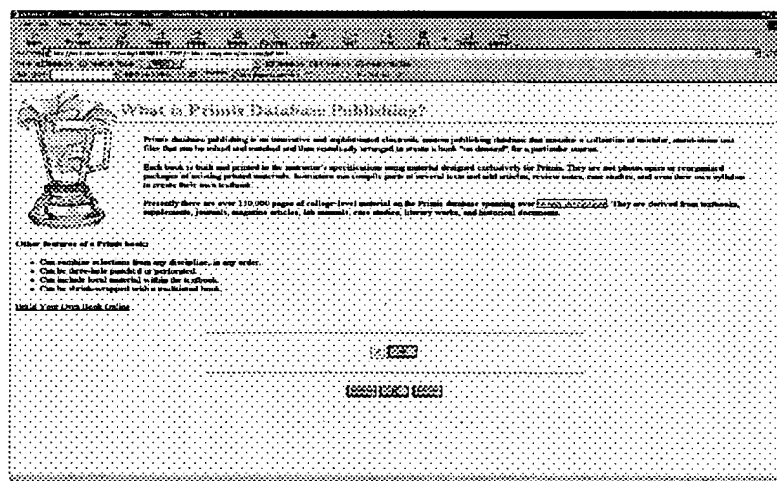


Regarding claims 7, 15 and 23, McGraw-Hill teaches all the claimed subject matters as discussed in claims 4, 12 and 20, McGraw-Hill further discloses *the user-provided content comprises a container* (McGraw-Hill Primis Custom Publishing).

Art Unit: 2162



Regarding claims 25-30, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 24, 9, 12, 17 and 20 McGraw-Hill further discloses *the received user-provided content is not of the content object and wherein the plurality of content entities define the content object as a compilation of related content* (McGraw-Hill Primis Custom Publishing).



Claims 2, 3, 5, 8, 10, 11, 13, 16, 18, 19, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies (McGraw-

Hill) [Build a Book Online,

<http://web.archive.org/web/19980513002459/http://mhhe.com/primis/> and

<http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt>] in view of Rowe

[USP 6,073,148].

Regarding claims 2, 5, 10, 13, 18 and 21, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 4, 9, 12, 17 and 20, but does not explicitly disclose the step of *receiving a user-provided location for inserting the identifier of the user-provided content into the content object, and inserting the identifier into the list at that location*. Rowe teaches a method for creating an optimized PDF file, by creating a list of objects and shared objects to organize the objects and place the objects in the optimized file in the same order (Rowe, Col. 10, Line58-Col. 11, Line 13). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including the technique of organizing the object in the list in order to build a customized e-book.

Regarding claims 3, 8, 11, 16, 19 and 24, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 2, 5, 10, 13, 18 and 21, Rowe further discloses the step of *providing a user interface communicating with the data repository, and providing mechanisms for receiving the user-provided content and specification of a desired location through the user interface* (Rowe, Col. 10, Line58-Col. 11, Line 13).

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing] in view of Santamaki et al. [USP 6,886,036 B1].

Regarding claim 31, McGraw-Hill teaches a method and system for building an e-book as *a content object stored as a plurality of content entities*.

As shown at screenshot III, the e-book as *content object is defined* by a list of chapters and sections as *content entity identifiers*.

The screenshot II includes a plurality of chapters such as *The American Heritage, Constitutional Democracy...* The content of a chapter are sections such as *New! Reading 2: The Mischiefs of Faction, James Madison...* The content of each section is the texts content indicated by the number of pages of text. A section under a chapter, or the text of a section is an example of the content that will be provided by user in order to compile a user own book by using the *Add* button (Screenshot III, and What is Primis Database Publishing in Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/>). When a user activate the *Add* button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the content of the chapter will be assigned an identifier that is the chapter name. Referring back to the screenshot II, four pages of text of *New! Reading 2: The Mischiefs of Faction, James Madison* as *user-provided content is received* by the server when activating the *Add* button, section name *New! Reading 2: The Mischiefs of*

Art Unit: 2162

Faction, James Madison as *an identifier* is assigned to four pages of the text. As in the Presentation Presenting How To Use Primis Online (Screenshot IV), a user could download the e-book as one way to purchase the book. In order to download the e-book, obviously, the e-book that contains *the user-provided content and its identifier* has to be stored in a data store at the server site as *an object server*.

The screenshot III illustrates a table of content or list of a user own book. The *list* is *added* with *New! Reading 2: The Mischiefs of Faction, James Madison* as *the identifier of the* four pages of text as *user-provided content* using the *Add* button of the screenshot III. The user can view four pages of *Reading 2: the Mischiefs of Faction, James Madison* as *user-provided content* by activating the *view* button.

The screen shot III with the button *view* for retrieving the content of a particular chapter implies the technique of *storing said custom content object in said one or more object servers; storing book number, format as attribute information concerning the custom content object in said one or more object servers*.

The missing of McGraw-Hill is a *library server* for storing the content of customized textbook in PDF format as *information specifying the custom content object and the attribute information*.

Santamaki teaches an electronic book method for distributing electronic reading materials. Santamaki further discloses an e-book server as a *library server* for storing the electronic document for later downloading to a remote terminal (Santamaki, Col. 2, Lines 25-28).

Art Unit: 2162

It would have been obvious for one of ordinary skill in the art at the time the invention was made to store the compiled textbook in an e-book server as taught by Santamaki for later downloading to a remote terminal.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E. BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HUNG Q PHAM
Examiner
Art Unit 2162

June 14, 2005



SHAHID ALAM
PRIMARY EXAMINER